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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,599	10/03/2003	Robert C. Lam	01239/01092	6145

43215 7590 08/02/2007

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EXAMINER	
STEELE, JENNIFER A	

ART UNIT	PAPER NUMBER
1771	

MAIL DATE	DELIVERY MODE
08/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/678,599	LAM ET AL.	
	Examiner	Art Unit	
	Jennifer Steele	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 May 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4 and 6-20* is/are pending in the application.

4a) Of the above claim(s) *20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4 and 6-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claim 1, 2, 4, 6-19 rejected under 35 U.S.C. 103(a) as being obvious over Chen et al EP 1203897. The claims do not contain any new limitations or subject matter and therefore the previous Office Action Rejection of 11/16/2006 are maintained.

2. Claim 1, 2, 4, 6-19 rejected under 35 U.S.C. 103(a) as being obvious over Lam et al US Patent 5998307 in view of Chen et al EP 1203897. The claims do not contain any new limitations or subject matter and therefore the previous Office Action Rejection of 11/16/2006 are maintained.

3. Claims 1,2,4,6-19 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6630416 to Lam et al as applied under 35 U.S.C. 102(f) substantially as set

forth in the previous action. The claims do not contain any new limitations or subject matter and therefore the previous Office Action Rejection of 11/16/2006 are maintained.

Terminal Disclaimer

4. The terminal disclaimer filed on 5/16/207 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,630,416 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

5. Applicant amended claim 7 to be dependent of claim 1 and the 35 USC § 112 rejection is withdrawn.

6. Applicant's arguments filed 5/16/2007 have been fully considered but they are not persuasive. Applicant argues that the specific limitations of the claims concerning the friction modifying particles was not obvious at the time of the invention as the advantages of this combination is not taught or suggested in the Chen EP reference. Applicant states that the performance requirements of the current invention are different than those that were the target when the technology covered by the Chen EP patent was developed. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., performance requirements) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993). The 35 USC §103 (a) rejection is based on the structure of the material and the motivation to combine the references to produce a friction material. The claims do not recite performance limitations and therefore the rejection is maintained.

7. Applicant argues that considerable research was invested to obtain the composition of the friction materials and that this composition would not of been obvious to combine the teachings of the two references to obtain the performance of the current applications invention. Applicant is arguing performance requirements that are not commensurate with the scope of the claims. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

8. Applicant's argument that the 35 USC 103(a) rejection as being obvious over Chen and Lam references appears to be a repeat of the rejection set forth in paragraph 3. Paragraph 7 states that claims 1,2,4,6-19 are rejected under 35 USC 103(a) as being unpatentable over '416 to Lam as applied under 35 USC 102(f) as set forth in the previous Office Action of 2/9/2006. Lam '307 and Lam '416 are not the same references and therefore the rejection of paragraph 3 is not the same as the rejection of paragraph 7. Applicant states that Lam '416 and Chen '897 EF patents are the same references, however examiner would like to clarify that they are not considered the same reference with the same priority date and publication date. While these two

references may be owned by the same assignee that does not qualify the two references to be identical and the same prior art.

9. Applicant's arguments with respect to Lam '416 over Chen EP are not persuasive. Applicant is arguing performance requirements that are not commensurate with the scope of the claims. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). If applicant invention has indeed unexpected results, it is the burden of the applicant to submit evidence that the current invention is different from the prior art.

10. Applicant's arguments with respect to Lam'416 patent is not considered prior art under 35 USC 102(f) are not persuasive. Applicant needs to resolve the issue of inventorship. One way to do this is to file an affidavit/declaration stating that they invented the subject matter claimed and did not derive the invention from the inventors of the '416 patent. The inventors of the '416 patent are Lam and Chen. The declaration states that the current application was derived of the inventors of '416. Dong was not an inventor of '416 and therefore the current application cannot be derived from the '416 patent.

11. Applicant's filed a terminal disclaimer and therefore the Double Patenting rejection is withdrawn. Submitting a terminal disclaimer does not preclude that patent from being considered prior art under 102. Terminal disclaimers have no relevance to

any references other than US patents and US patent applications and can not be used to remove a foreign reference.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Steele whose telephone number is (571) 272-7115. The examiner can normally be reached on Office Hours Mon-Fri 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elizabeth M. Cole/
Primary Examiner, Art Unit 1771

7/30/2007